

Application No. 09/905,017
Reply/Amendment dated October 23, 2003
Reply to Office Action dated August 27, 2003

REMARKS

In the Office action mailed on August 27, 2003, the Examiner finally rejected claims 1 through 12, 14, and 19 through 21. Specifically, the Examiner rejected claims 1 through 8, 12, 14, 20, and 21 under 35 U.S.C. §103(a) as being unpatentably obvious over the combination of Parker (US 5,769,830) and Samson I (US 5,462,523). The Examiner rejected claims 9 through 11 and 19 under 35 U.S.C. §103(a) as being unpatentably obvious over the combination of Parker, Samson I, and Samson II (US 6,053,903). Also, the Examiner stated the need to cancel claims 13 and 15 through 18, which are drawn to a non-elected invention.

The assignee of the present application herein provides a brief summary of a telephone interview between the undersigned attorney and the Examiner, cancels claims 13 and 15 through 18, and provides remarks regarding pending claims in order to present the claims in better condition for any appeal that may be sought.

1. Interview Summary

Initially, the assignee of the present application extends appreciation to the Examiner for the telephone interview conducted on October 16, 2003 at 1:00 Eastern Standard Time. In the interview, the undersigned attorney for the assignee described various differences between the pending claims and the cited references, which are described below. While no agreement was reached with respect to the allowability of the claims, the Examiner stated that she would consider the present Reply and Amendment filed under the provisions of 37 C.F.R. §1.116.

2. Cancellation of Claims 13 and 15 through 18

The assignee of the present application herein cancels claims 13 and 15 through 18 without prejudice or disclaimer. These claims are directed to a non-elected invention and have already been withdrawn from current consideration. The assignee of the

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application reserves the right to resubmit these claims, as well as other claims directed to the non-elected invention, during subsequent prosecution of the present or a related application.

3. Rejection of claims 1 through 8, 12, 14, 20, and 21

The assignee respectfully disagrees with the Examiner's characterization of the cited references, and asserts that the rejected claims define patentable subject matter.

In the subject Office action, the Examiner asserts that Parker teaches a medical device with a coil in a stressed, radially expanded condition. The assignee of the present application respectfully disagrees with this characterization of Parker for at least the following reasons. First, Parker does not disclose or suggest the use of a *coil*. Rather, Parker includes a *braid* (see element 26 in Figures 1 and 2). Throughout the specification, Parker refers to this element as a "reinforcing braid," and nowhere describes the element as a coil (see, for example, c.3, lines 51 through 55; c. 4, lines 38-40 and 49-51).

Second, even if the Examiner considers the braid of Parker to comprise a coil, Parker does not describe or suggest the braid as being in a "stressed, radially expanded condition," which is required by every pending claim in the present application.

The Examiner looks to Samson I to cure the alleged defects of Parker. Specifically, the Examiner alleges that Parker does not teach a braid extending over the coil, and that Samson I teaches such a braid. As described above, Parker actually does describe a braid, but does not describe or suggest the coil that is required by all claims.

Samson I describes both a braid and a coil (see elements 112 (braid) and 118 (coil) in Figure 2). Nevertheless, Samson I also cannot properly serve as a basis for rejection of any pending claim for at least the following reason. Samson I fails to anticipate or make obvious the claimed invention because it does not teach or suggest all limitations of any pending claim. Specifically, as discussed in the interview, Samson I does not teach or suggest that the coil is in a "stressed, radially expanded condition," which is required by every pending claim in the present application.

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In the invention described in the present application, the inclusion of a coil that is in a "stressed, radially expanded condition" is an important feature of the invention. Indeed, each and every pending claim includes this limitation. The specification also highlights the importance of this feature in devices according to the claimed invention. As described in the specification:

The stressed coil 14 of the present invention permits the medical device 10 of the present invention to have a wall which is thinner than might conventionally be achieved, and gives the medical device 10 more flexibility and springiness. During use, the tube 11 of the medical device 10 attempts to straighten, making it easier to control advancement of the medical device 10 in the patient. The stressed coil 14 also provides significant advantages during the manufacture of the medical device 10, most notably, better control over the wall thickness ultimately possessed by the medical device 10.

(page 11, paragraph beginning on line 14).

Furthermore, the "stressed, radially expanded condition" of the coil may become more clear upon review of the following section of the specification, which describes an exemplary process of constructing a tube according to the invention:

A mandrel is selected which has a diameter greater than the unstressed, free inner diameter of the coil 14....The coil 14 is then wrapped about the mandrel....the mandrel temporarily maintaining the coil 14 in an expanded condition. The braid 16 is then positioned over the coil 14. Finally, the polymeric layer 18 is established over the braid 16 and the coil 14....[T]he tube 11 [is] removed from the mandrel. The polymeric layer 18 now maintains the coil 14 in its stressed, expanded condition.

(page 11, paragraph beginning on line 23 and continuing through page 12, line 6, emphasis added).

4. Rejection of claims 9 through 11 and 19

For the rejection of these claims, the Examiner relies on Parker and Samson I for the same reasons above. The Examiner states that neither Parker nor Samson I teaches a polymeric layer of polyurethane or PTFE, or a heat shrinking tube with thermally bonded

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coil. The Examiner looks to Samson II to cure this defect of the Parker/Samson I combination for the rejection of these claims.

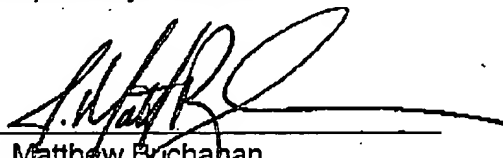
The assignee respectfully traverses this rejection at least for the reasons stated above in regards to the Parker/Samson I combination. Neither of these references, either taken alone or in combination, teach or suggest a coil in a "stressed, radially expanded condition," which is required for each of claims 9 through 11 and 19. Samson II does not cure this defect. While Samson II describes a "helically wound ribbon" (see element 202 in Figure 2), a review of the figures and specification of Samson II reveals a lack of any teaching or suggestion that the ribbon be in a "stressed, radially expanded condition." Thus, even if the Examiner views the "ribbon" of Samson II as the coil of the pending claims, the combination of Parker, Samson I, and Samson II does not produce each and every limitation of any pending claim, and therefore cannot properly serve as a basis for rejection.

CONCLUSION

The assignee respectfully asserts that the application is in condition for allowance on the next Office action. If, however, the Examiner feels that further personal communication would facilitate the prosecution of this case, the assignee requests that the Examiner contact its attorney at the number listed below.

Respectfully submitted,

Dated: October 23, 2003



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